

REMARKS

The Office states that the claims are directed to distinct inventions and requires restriction to one of Group I (claims 1-2, 4-16, 23-25, and 29-32) or Group II (claims 17, 19-22, and 26-27).

In response to the restriction requirement, Applicant elects Group I (claims 1-2, 4-16, 23-25, and 29-32). Applicant notes that pending claim 33 was not listed in either group. However, because claim 33 is dependent on claim 10, Applicant respectfully requests that claim 33 be included in Group I.

This election is made with traverse, as explained below.

First, in the interests of equity and fairness, Applicant should be entitled to pursue different types of claims in the present application, particularly apparatus and methods claims, to fully protect the disclosed invention. If the restriction is maintained, Applicant will need to bear the costs associated with pursuing two different patent applications to protect each type of claim.

Second, as is provided in 35 U.S.C. § 121, restriction to one of two or more claimed inventions is proper only if the inventions are “independent and distinct.” In the present case, Groups I and II, although not obvious in view of each other, are similar in subject matter. More specifically, each pertains to the expulsion of ink from print heads. For this reason, Applicant respectfully submits that the inventions described in the claims are not “independent” as defined in MPEP § 121 and that restriction between each of the Groups is improper.

Third, MPEP § 803 explicitly states that if search and examination of two or more inventions can be made without “serious burden,” the Examiner *must* examine each on the merits, even if the claims are directed to distinct or independent inventions. In this case, it appears that a search for the apparatus and method would be conducted within the same search class, 347. Moreover, two (2) non-final office actions have previously been issued by the Office in the present application. In neither of these office actions was a restriction requirement made, thus presumably a search of both claim types was made without serious burden. Applicant respectfully contends that the absence of a restriction requirement in these two prior office actions demonstrates that it would

not be overly burdensome on the Examiner to search for each of Applicant's claims at the same time.

For at least the foregoing reasons, Applicant respectfully traverses the restriction requirement and respectfully requests the Examiner to examine the claims of Groups I and II together. Applicant believes that all elected claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



Robert C. Sismilich

Reg. No. 41,314

Attorney for Applicant(s)

Telephone: (858) 547-9803

Date:

4/26/05

Hewlett-Packard Company
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400